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EXAMINER	
VAUGHN, GREGORY J	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURA L. MAHAN,
KELLY K. FORBES,
and SHAUN ILLINGWORTH

Appeal 2009-000935
Application 09/540,756
Technology Center 2100

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
JAY P. LUCAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-8, 14-26, 33-40, and 42, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention relates to a system for building a presentation having multimedia content. *See* Abstract.

Representative Claim

1. A method of building a presentation, the method comprising:

accessing a page including multimedia content from a multimedia source through a multimedia content application; and

subsequent to receiving user selection input while said page is accessed through said multimedia content application, automatically identifying multimedia content having a tag by parsing said page, and

copying said multimedia content having said tag from said multimedia source to memory, for access by a presentation application.

Examiner's Rejections

Claims 1-3, 6-8, 14-19, 22-26, 33, 35, and 37-40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gill (US 6,081,262).

Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gill.

Claims 4, 5, 20, 21, 34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gill and Fields (US 6,128,655).

FINDINGS OF FACT

Gill

1. Gill describes a menu driven multi-media presentation generation system (MPG), which accesses data from media sources S1-S6. Col. 5, ll. 8-17; Fig. 1.

2. The media objects from sources S1-S6 may include video information from Internet S4. Col. 5, l. 65 - col. 6, l. 8.

3. An author creates a multi-media presentation by placing multiple objects on a page (Fig. 2), such as a movie object MB which is obtained and stored in memory. Col. 8, l. 55 - col. 10, l. 13.

4. An export process (Fig. 4) allocates memory to store the data required for the presentation. The multi-media data is stored and processed by a page based document layout system. The data is identified by tags which note the multi-media nature of the particular data object. In creating an export object, the authoring tool queries the page based document layout system to locate multi-media information contained on the presentation pages. Col. 15, l. 34 - col. 16, l. 10.

5. Once the object information is collected, the authoring tool prepares the retrieved objects for export. Col. 16, ll. 11-15.

6. The multi-media presentation is exported as a non-editable object, which may be embodied as a single file for storage on a computer hard drive. Col. 17, ll. 9-45.

PRINCIPLES OF LAW

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citations omitted); *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

ANALYSIS

For claim 1, Appellants contend in the Appeal Brief[2] that Gill does not describe "subsequent to receiving user selection input while said page is accessed through said multimedia content application, automatically identifying multimedia content having a tag by parsing said page," and

[2] Filed January 17, 2008. The only arguments by Appellants that we have considered are contained in the Appeal Brief and the Reply Brief (filed June 16, 2008). We have reviewed none of the papers alleged to be "incorporated by reference" at page 2 of the Reply Brief. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.").

copying the multimedia content from the multimedia source to memory, for access by a presentation application.

The Examiner points out in the Answer that many of Appellants' arguments are not commensurate with the scope of claim 1. The Examiner further points out where each feature of claim 1, when properly interpreted, is deemed to be described in the reference.

Appellants respond, in turn, that Gill's disclosure is contrary to the instant invention, where "while" the page is being accessed by the multimedia content application, "the multimedia content is identified *based on* the received user selection input." Reply Br. 4 (emphasis added). According to Appellants, the "while" term means that the functions of "accessing" and "automatically identifying" are performed simultaneously. *Id*.

We agree with the Examiner that instant claim 1 is not as limiting as Appellants seem to allege. The claim does not recite what might occur in response to "receiving user selection input," and in particular does not require that the "automatically identifying" is in response to that, or any other, "user selection input." The claim requires that "subsequent to receiving user selection input while said page is accessed through said multimedia content application," the "automatically identifying" occurs. The claim thus requires no more than that the sub-step of "automatically identifying multimedia content having a tag by parsing said page" occurs *at some time after* some unspecified "user selection input" is received, rather than in response to, or as a direct consequence of, the "input."

We therefore are not persuaded that Gill fails to anticipate the subject matter of claim 1. In view of the breadth of claim 1, both the "accessing a

page" and the "receiving user selection input" can occur simultaneously, but prior to, automatically identifying multimedia content having a tag by parsing the page. We thus find no error in reading the "accessing" and "user selection input" on the authoring phase described by Gill, with the "automatically identifying" sub-step being read on the (later) export phase of Gill's system (col. 15, l. 35 *et seq.*). Further, the reference describes, in that export phase, "copying said multimedia content" to memory for access by a presentation application (*see* FF 5, 6) within the constraints of claim 1. However, the "copying" to memory could also occur during the authoring phase described by Gill, in view of the broad terms of the claim.

For claim 42, rejected under § 103(a) over Gill, Appellants appear to rely on substantially the same arguments presented for claim 1. *See* App. Br. 17. In any event, Appellants do not allege that it would not have been obvious for HTML tags to serve as the multi-media tags disclosed by Gill. Moreover, in view of the content of pages 1 and 8 of the Specification, HTML pages and HTML tags were widely used at the time of invention.

Appellants' arguments in response to the § 103(a) rejection over Gill and Fields are also unavailing, as the arguments rely on the issues we have considered in the rejection of claims 1 and 42.

We thus decide the appeal on the basis of claims 1 and 42. *See* 37 C.F.R. § 41.37(c)(1)(vii). We sustain the Examiners' rejections under §§ 102 and 103(a).

DECISION

The rejection of claims 1-3, 6-8, 14-19, 22-26, 33, 35, and 37-40 under 35 U.S.C. § 102(e) as being anticipated by Gill is affirmed.

The rejection of claim 42 under 35 U.S.C. § 103(a) as being unpatentable over Gill is affirmed.

The rejection of claims 4, 5, 20, 21, 34, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Gill and Fields is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

msc

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